

With respect to Invention IIIA and Invention IIIB, the Office Action further asserted that these claims are directed to patentably distinct species: IIIA Claim 38 and IIIB Claims 39-47.

I. Examiner Interview Summary.

On September 23, 2004, a telephonic Examiner interview was held between Examiner Heinrich and Applicants' attorney, Todd A. Rathe. The imposed restriction requirement upon the claims was discussed. No agreement was reached. Applicants wish to thank Examiner Heinrich for the opportunity to discuss the restriction requirement.

II. Election with Traverse.

Applicants hereby elect with traverse Invention I - Claims 1-24, drawn to methods for making a polymeric surface.

III. Traversal Restriction Between Invention I and Invention II.

The Office Action asserted that Claims 1-24 and 25-37 are drawn to distinct inventions. In particular, the Office Action asserted that the apparatus of Claims 25-37 can be used to practice another and materially different process such as cutting and melting. However, Claim 25 specifically recites an apparatus which includes a laser and a controller configured to generate control signals, wherein the laser is configured to form a lightened area upon a surface of an article and is also configured to form a darker mark over the lightened area in response to the control signals. To perform other processes such as cutting or melting would presumably additionally require a controller configured to generate control signals, wherein the laser cuts or melts in response to the control signals. Claim 25 recites no such

limitations. Thus, the article marking system recited in Claim 25 would not necessarily be able to perform such cutting or melting.

During the Examiner interview held on September 23, 2004, the Examiner asserted that the article marking system merely included a laser and a controller. However, the Examiner appears to be ignoring the functional claim limitation that the controller is configured to generate control signals that cause the laser to form a lightened area upon a surface of an article and also cause the laser to form a darker mark over the lightened area. As noted by MPEP § 806.05(e), the features are distinct if the apparatus as claimed can be used to practice another and materially different process. Thus, Applicants request that the restriction between Claims 1-24 and Claims 25-37 be withdrawn.

IV. Traversal of Restriction Between Invention I and Inventions IIIA and IIIB.

The Office Action asserted that Claims 25-37 are directed to a distinct invention as compared to Claim 38 or Claims 39-47. In particular, the Office Action asserted that "the marked articles can be made by the use of heating apparatus such as resistance heating apparatus or with the use of a preheated probe." However, Applicants respectfully note that the processor readable medium of Claim 38 is not a product made by the recited process of Claims 1-24. In contrast, Claim 30 is directed to a processor readable medium for directing a processor to generate control signals causing the process of Claim 1 to be carried out. Thus, Applicants request that the restriction as between Claims 1-24 and 38 be withdrawn.

Claim 39 specifically recites a laser marked article. Claim 39 further recites a laser-induced lightened area upon the surface. Claim 39 also recites a laser mark

over the lightened area. Accordingly, Applicants respectfully note that the laser-marked article of Claim 39 could not be made by the use of a heating apparatus such as resistance heating apparatus or the use of a preheated probe. In other words, a resistance heating apparatus or a preheated probe could not create a laser-induced lightened or a laser mark over the lightened area. A laser-induced lightened area and a laser mark would be structurally distinct from marks formed either by a resistance heating apparatus or a preheated probe. Thus, Applicants respectfully request that the restriction as between Claims 1-24 and 39-47 be withdrawn.

V. Traversal of Restriction Requirement Between Invention II and Inventions IIIA and IIIB.

The Office Action imposed a restriction requirement between Invention II and Inventions IIIA and IIIB by asserting that Claims 1-24 are directed to a distinct invention as compared to Claim 38 or Claims 39-47. In particular, the Office Action once again asserted that the apparatus recited in Claims 25-37 may alternatively be used for cutting or melting. However, as noted above in Section II above regarding the restriction between Invention I and Invention II, the apparatus of Claim 25 would not necessarily be capable of cutting or melting.

In asserting the restriction requirement, the Office Action appears to be overlooking the functional limitation of Claim 25 which recites that the controller is configured to generate control signals, wherein the laser is configured to form a lightened area upon a surface of an article and is also configured to form a darker mark over the lightened area in response to the control signals. The functional limitations are accorded patentable significance. See MPEP § 2173.05(g).

Accordingly, Applicants respectfully request that the restriction as between Claims 25-37 and Claim 38 or Claims 39-47 be withdrawn.

VI. Traversal of Species Restriction Between Invention IIIA and Invention IIIB.

Page 3 of the Office Action asserted that

This application contains claims directed to the following patentably distinct species of the claimed invention:

IIIA: Claim 38, drawn to an article comprising processor readable medium.

IIIB. Claims 39-47, drawn to a polymeric laser marked articles.

The Office Action further asserted that this reply must include an identification of the species elected consonant with the requirement and a listing of all claims readable thereon.

Applicants respectfully assert that this restriction requirement is improper and request that this restriction requirement be withdrawn. As noted by MPEP § 806.04(e), "Claims are definitions of inventions. Claims are never species. . . . Species are always specifically different embodiments." The Office Action has failed to recite any embodiments which it considers to constitute distinct species. Claim 38 and Claims 39-47 cannot constitute species. Although the Office Action asserts that this Reply must include an identification of the species and a listing of all claims readable thereon, Applicants cannot do so because no species have been identified in the Office Action. Thus, Applicants request that this species restriction be withdrawn.

VII. Conclusion.

With this response, Claims 1-24 are elected with traverse. Applicants request that each of the restriction requirements imposed upon Claims 1-47 be withdrawn.

Reconsideration and allowance of Claims 1-47 are respectfully requested.

Respectfully submitted,

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